

REMARKS

Claims 23-38 remain pending in the present application. None of the claims have been amended.

DOUBLE PATENTING

The Examiner has rejected Claims 23-38 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-22 of U.S. Patent No. 6,729,413.

Applicants submitted a Terminal Disclaimer on September 16, 2005 (copy enclosed). The Examiner acknowledged receipt of the Terminal Disclaimer in the Office Action mailed October 17, 2005.

Thus, Applicants believe the obviousness-type double patenting rejection has been met and is believed to overcome the Examiner's objection.

REJECTION UNDER 35 U.S.C. §103(a)

The Examiner has rejected Claims 23-38 under 35 U.S.C. §103(a) as being unpatentable over Mooty et al. (U.S. Patent No. 6,656,626) in view of Maeda et al. (U.S. Patent No. 5,189,570). The Examiner alleges that this combination would render Applicant's invention obvious to those skilled in the art.

Applicants' invention relates to a power tool housing having a mechanism for rejecting a battery pack. The mechanism includes, among other elements, a frame in a base, a cavity in the frame for receiving a battery pack at the distal end of the handle portion, a member to receive a member on the battery pack to couple the battery with the power tool. A biasing member is in the cavity. The biasing member ejects the

battery pack from the receiving member. The battery pack is received in the receiving member so that the battery pack is in contact with the biasing member such that when the battery pack is secured on the frame, the biasing member is in a compressed condition and when the battery pack is released from the frame, the biasing member ejects the battery pack from the frame.

The Examiner alleges that Mooty et al. in view of Maeda et al. would render Applicants' claims obvious to those skilled in the art. The Examiner provides the Mooty et al. reference, which includes a manual closure member to lock the battery in place. The lever is pushed so that it moves out of the way from a locked to release positions so that the user can manually release the battery from the drill. The Examiner combines Mooty et al. with the Maeda et al. Maeda et al. relates to a magnetic head advancing/retracting device for rotating magnetic recording media. The device includes a mechanism for automatically ejecting a battery pack. The battery pack is ejected upon sensing of a low power level.

A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art. This requires that the Examiner review each reference as a whole before combining them together. The Mooty et al. reference relates to power tools, while Maeda et al. relates to magnetic head advancing and retracting device.

The Examiner, in applying the references, indicates that Maeda et al. shows a feature and concludes that it would have been obvious to modify Mooty et al. in view of

Maeda et al. The Examiner has failed to provide any logical reasoning as to why this is the case. The Court requires the Board (Examiner):

“to explain the reasons one of ordinary skilled in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. This entails consideration of both the scope and content of the prior art and the level of ordinary skill in the pertinent art. When the Board (Examiner) does not explain the motivation, or the suggestion or teaching, that would have lead the skilled artesian at the time of the invention to the claimed combination as a whole, we infer that the Board used hindsight to conclude that the invention was obvious.” In re Kahn, 78 USPQ2d 1329 (1334-1335).

“To reach a non-hindsight driven conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject matter as whole to have been obvious in view of multiple references, the Board must provide some rationale, articulation, or reason basis to explain why the conclusion of obviousness is correct.” In re Kahn, supra, at 1336.

Here, the Examiner has provided a naked conclusion with no rationale or reasoning as to one skilled in the art, after reviewing the two references as whole, would come to this conclusion.

The Court further stated:

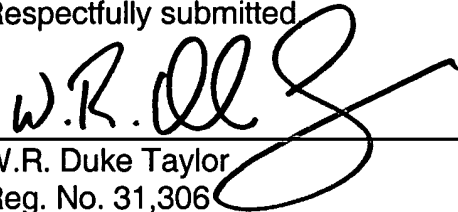
“Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness.” This requirement ... ensures due process and non-arbitrary decision making as it is in §103. Id. at 1336

Thus, the Examiner’s lack of reasoning and rationale fails to meet the standard of a proper §103 rejection. Accordingly, by providing only a mere conclusory statement, the Examiner’s rejection cannot stand.

Thus, Applicants would submit that all pending claims are in condition for allowance. Accordingly, Applicants respectfully request the Examiner to pass the case to issue at his earliest possible convenience.

Should the Examiner have any questions regarding the present application, he should not hesitate to contact the undersigned at (248) 641-1600.

Respectfully submitted



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